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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,274	10/17/2001	Ryan Lance Levin	7802-A07-003	8186

33771 7590 10/17/2008

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MIAMI, FL 33180

EXAMINER

COBANOGLU, DILEK B

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

10/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/982,274

Applicant(s)

LEVIN ET AL.

Examiner

DILEK B. COBANOGLU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 8/6/2008 has been entered.

2. Claims 1-10, 12, 14-17 remain pending in this application.

Specification

New Matter

3. Applicant's argument is persuasive; the new matter rejection has been withdrawn. Examiner thanks the applicant for providing the paragraphs, which cite "the insurance provider define, offer and monitor a plurality of health related facilities and services".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-10, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (hereinafter Douglas) (U. S. Patent No. 6,039,688) in view of Applicant's admitted prior art.

A. Claim 1 recites a method of managing the use of a medical insurance plan by members thereof, the method comprising:

- i. receiving, by an insurance provider, one of a premium payment and a contribution payment from members of the medical insurance plan (Douglas; col. 2, lines 9-22, col. 5, lines 28-34), wherein the insurance provider undertakes liability in the medical insurance plan in response to receiving one of the premium payment and the contribution payment (Douglas; col. 2, lines 9-22, col. 5, lines 28-34);
- ii. providing, by the insurance provider, to members who one of pay such premiums and make such contributions, at least one of
 - a. relevant health services (Douglas; col. 2, lines 9-22, col. 5, lines 27-44, col. 6, lines 27-48), and

Also, Examiner notes that Applicant's admitted prior art, "the definition of business of a medical scheme" reads that the medical scheme is a business of undertaking liability in return for a premium or contribution...to render a relevant health service...by medical scheme itself (present specification; page 2).

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- b. assistance in defraying expenses incurred in connection with rendering such relevant health services
- iii. defining, by the insurance provider, at least one of a plurality of health-related facilities and a plurality of health-related services to be associated with the medical insurance plan (Douglas; col. 2, lines 9-22, col. 5, lines 28-34, col. 6, lines 7-13, 40-48);
- iv. offering, by the insurance provider, the at least one of a plurality of health-related facilities and a plurality of health-related services to members of the medical insurance plan (Douglas; Douglas; col. 2, lines 9-22, col. 5, lines 28-34, col. 6, lines 7-13, 40-48);
- v. monitoring, by the insurance provider, usage of the at least one of a plurality of health-related facilities and a plurality of health-related services by each member (Douglas; col. 5, lines 28-34, col. 7, lines 54-65 and col. 10, lines 9-16);
- vi. allocating, by the insurance provider in response to the monitoring, a credit value to each member according to their use of the at least one of a plurality of health-related facilities and a plurality of health-related services (Douglas; col. 5, lines 28-34, col. 14, lines 38-42); and
- vii. allocating, by the insurance provider, rewards to members who accumulate credit values exceeding predetermined values (Douglas; col. 14, lines 42-47).

Douglas fails to expressly teach that "the insurance provider undertakes liability in the medical insurance plan in response to receiving one of the premium payment and the contribution payment and providing, by the insurance provider, to members who one of pay such premiums and make such contributions, at least one of relevant health services, and assistance in defraying expenses incurred in connection with rendering such relevant health services."

However, these features are well known in the art, as evidenced by Applicant's admitted prior art.

In particular, Applicant's admitted prior art discloses definition of the term "business of a medical scheme": the business of undertaking liability in return for a premium or contribution a) to make provision for the obtaining of any relevant health service; b) to grant assistance in defraying expenditure incurred in connection with the rendering of any relevant health service; and c) where applicable, to render a relevant health service, either by the medical scheme itself, or by any supplier or group of suppliers of a relevant health service or by any person, in association with or in terms of an agreement with a medical scheme;" (par.: 0012-0016).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as

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disclosed by Applicant's admitted prior art, which is the definition of a medical plan, with the motivation of providing clarification of the benefits of an insurance plan.

B. Claim 2 recites the method according to claim 1 wherein the at least one of a plurality of health-related facilities and a plurality of health-related services includes at least one of the group consisting of membership of health clubs, membership of gymnasiums, membership of fitness programs, weight loss programs, and programs to quit smoking (Douglas; col. 5, line 60 to col. 6, line 6).

C. Claim 3 recites the method according to claim 2 wherein the at least one of a plurality of health-related facilities and a plurality of health-related services further includes predetermined preventive medical procedures (Douglas; col. 2, lines 23-47, col. 6, lines 7-13, 40-48).

D. Claim 4 recites the method according to claim 2 wherein the at least one of a plurality of health-related facilities and a plurality of health-related services further includes a medical advice service (Douglas; col. 14, lines 46-52 and col. 15, lines 1-4).

E. Claim 5 recites the method according to claim 2 wherein the at least one of a plurality of health-related facilities and a plurality of health-related services further includes predetermined procedures (Douglas; col. 15, lines 25-39).

F. Claim 6 recites the method according to claim 5 wherein the predetermined procedures include at least one of the group consisting of

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advance pre-authorization of hospitalization, advance pre-authorization of treatment, registration for electronic funds transfer and compliance with preferred procedures (Douglas; col. 5, lines 45-51).

G. Claim 7 recites the method according to claim 1 wherein a reward allocated to a member is at least one of linked to number of annual claims associated with the member and whether or not the member has been hospitalized, in a predetermined period of time (Douglas; col. 14, lines 38-42 and col. 17, line 64 to col. 18, line 5, col. 20, lines 38-47).

H. Claim 8 recites the method according to claim 7 wherein the reward allocated to the member includes at least one of the group consisting of: prizes allocated on a basis of a draw, a magnitude of a member's credit value being related to a chance of winning the draw, access to at least one of health-related facilities and health-related services for family members, decreased premium payments according to a predetermined plan, and increased benefit payments according to a predetermined plan (Douglas; col. 5, lines 52-59).

I. Claim 9 recites the method according to claim 1 wherein a reward allocated to a member is not actually given to the member before at least one of a predetermined period has passed or the member has attained a predetermined age (Douglas; col. 18, line 66 to col.19, line 2).

J. Claim 10 recites the method according to claim 9 wherein the reward allocated is forfeited by the member if they are not still a member of the medical insurance plan after the predetermined period has passed

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or after the member has attained such predetermined age (Douglas et al.; col. 14, lines 38-47).

K. Claim 14 recites the method according to claim 1, further comprises:

i. the insurance provider offering the at least one of a plurality of health-related facilities and a plurality of health-related services in conjunction with third party service providers that provide at least one of health related facilities and health-related services in the at least one of a plurality of health-related facilities and a plurality of health-related services offered by the insurance provider(Douglas; col. 5, lines 28-38); and

ii. monitoring usage of the at least one of health-related facilities and health-related services provided by the third party service providers by members by receiving information from the third party service providers detailing the use usage of the at least one of health-related facilities and health-related services by the members (Douglas; col. 6, lines 2-6, Fig. 1).

L. Claim 15 recites the method according to claim 14 wherein the members only pay a once off activation fee to gain access to the at least one of a plurality of health-related facilities and a plurality of health-related services (Douglas; col. 2, lines 9-22).

M. Claim 16 recites the method of claim 1, further comprising: providing, by the insurance provider, one of a full payment and a partial

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payment to one of a health-related facility and a health-related service in the at least one of a plurality of health-related, facilities and a plurality of health-related services that has been used by a member of the medical insurance plan, wherein the one of a full payment and a partial payment is on behalf of the member.

Douglas fails to expressly teach providing, by the insurance provider, one of a full payment and a partial payment to one of a health-related facility and a health-related service in the at least one of a plurality of health-related, facilities and a plurality of health-related services that has been used by a member of the medical insurance plan, wherein the one of a full payment and a partial payment is on behalf of the member.

However, these features are well known in the art, as evidenced by Applicant's admitted prior art.

In particular, Applicant's admitted prior art discloses definition of the term "business of a medical scheme": the business of undertaking liability in return for a premium or contribution a) to make provision for the obtaining of any relevant health service; b) to grant assistance in defraying expenditure incurred in connection with the rendering of any relevant health service; and c) where applicable, to render a relevant health service, either by the medical scheme itself, or by any supplier or group of suppliers of a relevant health

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service or by any person, in association with or in terms of an agreement with a medical scheme;" (par.: 0012-0016).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Applicant's admitted prior art, which is the definition of a medical plan, with the motivation of providing clarification of the benefits of an insurance plan.

N. Claim 17 recites the method of claim 1, further comprising: providing, by the insurance provider, discounted usage fees to the members for the at least one of a plurality of health-related facilities and a plurality of health-related services.

Douglas fails to expressly teach providing, by the insurance provider, discounted usage fees to the members for the at least one of a plurality of health-related facilities and a plurality of health-related services.

However, these features are well known in the art, as evidenced by Applicant's admitted prior art.

In particular, Applicant's admitted prior art discloses definition of the term "business of a medical scheme": the business of undertaking liability in return for a premium or contribution a) to make provision for the obtaining of any relevant health service; b) to grant assistance in defraying expenditure incurred in connection with the rendering of any relevant health service; and c) where applicable,

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to render a relevant health service, either by the medical scheme itself, or by any supplier or group of suppliers of a relevant health service or by any person, in association with or in terms of an agreement with a medical scheme" (par.: 0012-0016).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Applicant's admitted prior art, which is the definition of a medical plan, with the motivation of providing clarification of the benefits of an insurance plan.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (hereinafter Douglas) (U.S. Patent No. 6,039,688), Applicant's admitted prior art and further in view of Ballantyne et al. (hereinafter Ballantyne) (U.S. Patent No. 5,867,821).

A. Claim 12 recites the method according to claim 3 wherein the preventive medical procedures include vaccinations.

Douglas fails to expressly teach the vaccination information.

However, this feature is well known in the art, as evidenced by Ballantyne.

In particular, Ballantyne discloses vaccination information (Ballantyne; col. 15, lines 41-47).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as

disclosed by Ballantyne with the motivation of enhancing healthcare quality (Ballantyne; col. 2, lines 55-62).

Response to Arguments

7. Applicant's arguments filed 8/6/2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.

A. In response to Applicant's argument about Douglas does not teach "insurance provider defines a plurality of health-related services and a plurality of health-related services to be associated with the medical insurance plan; offer at least one of plurality of health-related facilities and a plurality of health-related services to members of the medical insurance plan... allocates a credit value to each member according to their use of the at least one of a plurality health-related facilities and a plurality of health-related services; and allocate rewards to members who accumulate credit values exceeding predetermined values."; Examiner respectfully submits that Douglas teaches "...an integrated, computer-implemented, electronically deliverable patient therapeutic behavior modification program, compliance, **monitoring, and feedback system** which supports the design of customized therapeutic behavior and lifestyle modification programs for **subscribers**; accepts the input of current health data for these patients; enables the review of these health records by a physician; **enables the performance of aggregate reviews of such records by**

health plan payors, such as HMOs, insurance companies, and large self-insured employers; and **motivates the patient to comply with the program** and make the necessary lifestyle changes through an integrated system of interactive graphical interfaces.” In col. 2, lines 9-22. “Referring to FIG. 1, in a presently preferred embodiment of the invention, the patient 10, physician 12, case advisor 14, and **health plan payor 16 (such as an HMO, insurance company or self-insured employer), all provide input to and/or receive output from the therapeutic behavior modification program's compliance monitoring and feedback system.** The case advisor may be a doctor, nurse, and/or other trained medical professional experienced in case management protocols and practices. Patients electronically interact with the system, the case advisor and their doctor through the system interface 18. The behavior modification program is customized to fit the health care and recovery needs of individual patients. The system provides at least two separate benefits: it helps the patient comply with the program through an electronically-implemented support mechanism; and further assists in monitoring such compliance” in col. 5, lines 28-44. Also, in col. “19, lines 49-57, Douglas teaches “The user interface for the health plan payor is similar to the user interface used by a physician/case advisor. When the health plan payor signs onto the system, a main menu screen with a list of options available is provided, as shown in FIG. 49. From here, the payor may choose to view overall compliance status 350, perform case management review 352, perform an

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utilization review 356, review outcomes 354, or communicate 358, each of which options is described in further detail below.” The payor is monitoring the therapeutic behavior modification program.

B. In response to Applicant’s argument about Douglas does not teach “member’s annual claims and allocating a reward to a member based on the number of annual claims and/or whether or not the member has been hospitalized in a predetermined period of time”; Examiner respectfully submits that Douglas teaches “A therapeutic behavior modification program, compliance monitoring and feedback system (abstract), an integrated, computer-implemented, electronically deliverable patient therapeutic behavior modification program, compliance, monitoring, and feedback system which supports the design of customized therapeutic behavior and lifestyle modification programs for subscribers; accepts the input of current health data for these patients; enables the review of these health records by a physician; enables the performance of aggregate reviews of such records by health plan payors, such as HMOs, insurance companies, and large self-insured employers; and motivates the patient to comply with the program and make the necessary lifestyle changes through an integrated system of interactive graphical interfaces (in col. 2, lines 9-22), “The rewards feature is yet another motivational tool provided by the system. Referring again to FIG. 9, the reward “apples” icon 92 allows a user to view information on the rewards point system and how it works, as well as the user’s own personal rewards account. Users may

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earn points by good participation in the program and by reaching certain milestones.” (in col. 14, lines 38-47), and “Referring back to FIG. 49, another option provided by the main menu 348 is a review outcomes 354 option, which provides a screen like the one shown in FIG. 55 with information as to the various patient outcomes, based on various pre-determined categories. For instance, information as to the percent of compliant subscribers who had an emergency room (“ER”) visit 420 is shown.” (in col. 20, lines 38-47)

C. In response to Applicant’s argument about Douglas does not teach “the reward allocated to the member includes at least one of the group consisting of: prizes allocated on a basis of a draw, a magnitude of a member’s credit value being related to a chance of winning the draw, access to at least one of health-related facilities and health-related services for family members, decreased premium payments according to a predetermined plan, and increased benefit payments according to a predetermined plan”; Examiner respectfully submits that the claim recites “at least one of the group”, and Douglas teaches access to at least one of health-related facilities and health-related services for family members (reads as The wellness group may further include family members of the clinical group who may need group support and/or counseling in dealing with the family member’s chronic illness.) (Douglas; col. 5, lines 52-59).

D. In response to Applicant’s argument about Douglas would have to teach that after the patient is allocated his/her award for not smoking 60

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days the patient is not given the reward until a predetermined time has passed and/or until the user has passed a predetermined age; Examiner respectfully submits that Douglas teaches "FIG. 46 also shows an example of a patient who has earned reward points 324 for not having smoked for 60 days." In col. 18, line 66 to col. 19, line 2.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach Computer directed exercising apparatus 4556216 A, System for skip rope exercising 4699375 A, Fitness and nutrition game apparatus and method of play 5062645 A, All care health management system 5301105 A, Computerized healthcare accounts receivable purchasing collections securitization and management system 5550734 A, Character thinning using emergent behavior of populations of competitive locally independent processes 5574803 A, Fitness feedback system for weight stack machines 5655997 A, Process and system for arrangement of documents 5745893 A, Behavior prediction for rule-based data processing apparatus 5832467 A, System for exchanging health care insurance information 5890129 A, Computer apparatus and method for generating documentation using a computed value for a claims cost affected by at least one concurrent, different insurance policy for the same insured 6163770 A, Systems and methods for improved health care compliance 20060218011, Method and apparatus for lifestyle risk evaluation and insurability determination.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DILEK B. COBANOGLU whose telephone number is (571)272-8295. The examiner can normally be reached on 8-4:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. B. C./
Examiner, Art Unit 3626
10/14/2008

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626